



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/816,011	03/11/1997	MARK H. PAUSCH	34.421-C2	6532

7590 12/31/2001

FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, LLP
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

EXAMINER

PAK, MICHAEL D

ART UNIT PAPER NUMBER

1646

DATE MAILED: 12/31/2001

33

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/816,011

Applicant(s)
Pausch et al.

Examiner
Michael Pak

Art Unit
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 15, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 36-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-33 and 36-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Election/Restriction

1. Applicant's election with traverse of Group I, claims 1-33 and 36-39 in Paper No. 8 is acknowledged.

A new restriction requirement is recast and set forth below.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17 and 36-39, drawn to a *Drosophila* potassium channel DmORF1, classified in Class 530, subclass 350.

II. Claims 1-16, 18 and 36-39, drawn to a *C. Elegans* CeOrf1 potassium channel encoded by SEQ ID NO:3, classified in Class 530, subclass 350.

III. Claims 1-16, 18 and 36-39, drawn to a *C. Elegans* CORK potassium channel of SEQ ID NO:63, classified in Class 530, subclass 350.

IV. Claims 1-15, 19-21 and 36-39, drawn to a human hORK potassium channel of SEQ ID NO:45, classified in Class 530, subclass 350.

V. Claims 1-15, 19-21 and 36-39, drawn to a human est potassium channel of SEQ ID NO:54, classified in Class 530, subclass 350.

VI. Claims 22, 24, 27, 29-30 and 33, drawn to an isolated nucleotide sequence *C. Elegans* Cork of SEQ ID NO:36, an

Serial Number: 08/816,011
Art Unit: 1646

2

expression vector, a transformed yeast cell, and a kit,
classified in Class 536, subclass 24.5.

VII. Claims 23, 25, 28-30, and 33, drawn to an isolated
nucleotide sequence encoding HORK, an expression vector, a
transformed yeast cell, and a kit, classified in Class 536,
subclass 24.5.

VIII. Claims 24, 27, 29-30 and 33, drawn to an isolated
nucleotide sequence encoding DmORF1, an expression vector, a
transformed yeast cell, and a kit, classified in Class 536,
subclass 24.5.

IX. Claims 26, 28, 29-30, and 33, drawn to an isolated
nucleotide sequence of human SEQ ID NO:51, an expression vector,
a transformed yeast cell, and a kit, classified in Class 536,
subclass 24.5.

X. Claims 26, 28, 29-30, and 33, drawn to an isolated
nucleotide sequence of mouse SEQ ID NO:52, an expression vector,
a transformed yeast cell, and a kit, classified in Class 536,
subclass 24.5.

XI. Claims 26, 28, 29-30, and 33, drawn to an isolated
nucleotide sequence of mouse SEQ ID NO:53, an expression vector,
a transformed yeast cell, and a kit, classified in Class 536,
subclass 24.5.

XII. Claims 31-32, drawn to a method of assaying substances
to determine effects on cell growth, Class 435, subclass 7.2.

The inventions are distinct, each from the other because of the following reasons.

The products of Groups I-XI are distinct because the product of groups I-XI are structurally and functionally different from each other.

The products of Group I-XI, and the processes of invention XII, are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of Group III can be practiced with alternatively products of groups I-XI.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classifications and the search required for any one of inventions I-XII is not required for any other invention I-XII, thus, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims

Serial Number: 08/816,011
Art Unit: 1646

4

to a non-elected invention, the inventorship must be amended in compliance with 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Sequence Rules 37 CFR 1.821-1.825

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Figure 3 discloses an amino acid sequence which is not identified in the brief description of drawings. It is suggested that all sequences be labeled with the correct SEQ ID NO: next to the sequence in the specification or in the brief description of drawings.

Examiner requests a brief summary of the sequence listings. It is not clear where some of the sequences are fragments of a larger sequence and when the sequences are different sequence.

Serial Number: 08/816,011
Art Unit: 1646

5

Also on page 68 of the specification, SEQ ID NO: 55 and 62 appear to be the same sequence.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Michael D. Pak
Michael Pak
Primary Patent Examiner
Art Unit 1646
26 December 2001